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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,789	07/26/2001	Lieping Chen	07039-219001	6835
26191	7590	11/26/2003	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA 60 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402			ROARK, JESSICA H	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/915,789

### Applicant(s)

CHEN, LIEPING

### Examiner

Jessica H. Roark

### Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 10-31 and 34-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 32, 33 and 53-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 882003 . 6) ☐ Other: \_\_\_\_\_

Art Unit: 1644

### RESPONSE TO APPLICANT'S AMENDMENT

1. Applicant's amendment, filed 8/8/03, is acknowledged.

Claims added: 53-58.

Claims currently amended: 1-3.

Claims pending: 1-58.

Claims 4-6, 10-31 and 34-52 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Paper filed 11/22/02.

*Claims 1-3, 7-9, 32-33 and 53-58 are under consideration in the instant application.*

2. This Office Action will be in response to applicant's arguments, filed 8/8/03.

The rejections of record can be found in the previous Office Action.

It is noted that New Grounds of Rejection are set forth herein.

#### ***35 USC § 112 second paragraph***

3. Applicant's amendment, filed 8/8/03, has obviated the previous rejection of claims 1-3, 7-9 and 32-33 under 35 U.S.C. 112, second paragraph.

#### ***35 USC § 112 first paragraph***

4. Applicant's amendment, filed 8/8/03, has obviated the previous rejection of claims 1-3, 7-9 and 32-33 under 35 U.S.C. 112, first paragraph, enablement.

5. Applicant's amendment, filed 8/8/03, has obviated the previous rejection of claims 1-3, 7-9 and 32-33 under 35 U.S.C. 112, first paragraph, written description.

#### ***Claim Rejections – 35 U.S.C. § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

*(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

Art Unit: 1644

7. The Chen Declaration filed on 8/8/03 under 37 CFR 1.131 has been considered but is ineffective to overcome either the Baker et al. (WO99/63088, IDS #AL), Mitcham et al. (US Pat. No. 6,468,546, see columns 1-34 and 305-312, of record), or Fox et al. (US 2002/0165347, of record) reference.

A) The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in *the United States or a NAFTA or WTO member country* after the effective date of the reference.

Although Applicant's Declaration states that Applicant worked in "this country", no evidence is set forth in the Declaration as to the identity of "this country".

In addition, the instant claims are drawn to a genus of nucleic acids, whereas the evidence provided in the Declaration is limited to a single nucleic acid sequence. The scope of the declaration is thus not commensurate with the scope of the claims.

B) Further, the Fox et al. (US 2002/0165347, of record) reference is a U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

8. Claims 1-3, 7-9, 32-33 and 53-58 are rejected under 35 U.S.C. 102(a) as being anticipated by Baker et al. (WO99/63088, IDS #AL).

Applicant's argument, filed 8/8/03, that Baker et al. is not available as a reference in view of the Chen Declaration under 37 C.F.R. 1.131, also filed 8/8/03, has been fully considered, but for the reasons set forth supra has not been found convincing.

As previously noted, Baker et al. teach the DNA encoding the membrane-bound protein PRO1219. The DNA encoding PRO1291 is 100% identical to the full length sequence of instant SEQ ID NO:6 (compare SEQ ID NO:6 to the sequence shown in Figure 207).

Baker et al. also teach vectors comprising the DNA, host cells comprising said vectors and method for expressing the protein encoded by the DNA (e.g., page 280). The vectors taught must include those in which the nucleic acid is operably linked to a regulatory element to permit expression of the sequence because expression of the polypeptide is explicitly taught. Given that the PRO1219 protein is the same protein encoded by instant SEQ ID NO:6, the co-stimulation of T cell proliferation would be an inherent functional property of the encoded PRO1291 polypeptide.

It is noted that because Baker et al. teach a sequence identical to instant SEQ ID NO:6, this nucleic acid would hybridize under the newly recited conditions. The nucleic acid also encodes a polypeptide comprising the residues set forth in newly added claims 54-58 and amended claim 2.

Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations would be inherent properties of the DNA encoding the PRO1291 polypeptide. The reference teachings thus anticipate the instant claimed invention.

The rejection is maintained as applied to the amended claims.

Art Unit: 1644

9. Claims 1-3, 7-9, 32-33 and 53-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitcham et al. (US Pat. No. 6,468,546, see columns 1-34 and 305-312, of record).

Applicant's argument, filed 8/8/03, that Mitcham et al. is not available as a reference in view of the Chen Declaration under 37 C.F.R. 1.131, also filed 8/8/03, has been fully considered, but for the reasons set forth supra has not been found convincing.

As previously noted, Mitcham et al. teach the DNA of SEQ ID NO:391, encoding ovarian carcinoma protein of SEQ ID NO:393. The DNA encoding SEQ ID NO:393 is 100% identical to the full length sequence of instant SEQ ID NO:6 (compare SEQ ID NO:6 to the sequence shown in SEQ ID NO:391) .

Mitcham et al. also teach vectors comprising the DNA, host cells comprising said vectors and method for expressing the protein encoded by the DNA (c.g., columns 9 and 12). The vectors taught must include those in which the nucleic acid is operably linked to a regulatory element to permit expression of the sequence because expression vectors and expression of the polypeptide are explicitly taught at column 12, especially lines 3-21. Given that instant SEQ ID NO:6 and SEQ ID NO:391 of Mitcham et al. encode identical proteins, co-stimulation of T cell proliferation would be an inherent functional property of the polypeptide of SEQ ID NO:393 encoded by SEQ ID NO:391 of Mitcham et al.

Because Mitcham et al. teach a sequence identical to instant SEQ ID NO:6, this nucleic acid would hybridize under the newly recited conditions. The nucleic acid also encodes a polypeptide *comprising* the residues set forth in newly added claims 54-58 and amended claim 2.

Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations would be inherent properties of the SEQ ID NO:391 encoding the polypeptide of SEQ ID NO:393 taught by Mitcham et al.

The reference teachings thus anticipate the instant claimed invention.

The rejection is maintained as applied to the amended claims.

10. Claims 1-3, 7-9, 32-33 and 53-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Fox et al. (US 2002/0165347, of record, see entire document).

Applicant's argument, filed 8/8/03, that Fox et al. is not available as a reference in view of the Chen Declaration under 37 C.F.R. 1.131, also filed 8/8/03, has been fully considered, but for the reasons set forth supra has not been found convincing.

As previously noted, Fox et al. teach the DNA of SEQ ID NO:1, encoding the B7-L protein of SEQ ID NO:2. The DNA of SEQ ID NO:1 encoding SEQ ID NO:2 is 100% identical over the full length coding region of instant SEQ ID NO:6 (compare SEQ ID NO:6 to the sequence shown in SEQ ID NO:1 as encoding SEQ ID NO:2) .

Fox et al. also teach vectors comprising the DNA, host cells comprising said vectors and method for expressing the protein encoded by the DNA (e.g., paragraphs 146-206 and claims). The vectors taught include those in which the nucleic acid is operably linked to a regulatory element to permit expression of the sequence (e.g., paragraphs 157-180). Given that instant SEQ ID NO:6 and SEQ ID NO:1 of Fox et al. encode identical proteins, co-stimulation of T cell proliferation would be an inherent functional property of the polypeptide of SEQ ID NO:2 encoded by SEQ ID NO: 1 of Fox et al.

Art Unit: 1644

Because Fox et al. teach a sequence identical to instant SEQ ID NO:6, this nucleic acid would hybridize under the newly recited conditions. The nucleic acid also encodes a polypeptide *comprising* the residues set forth in newly added claims 54-58 and amended claim 2.

Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations would be inherent properties of the DNA of SEQ ID NO:1 encoding the polypeptide of SEQ ID NO:2 of Fox et al.

The reference teachings thus anticipate the instant claimed invention.

The rejection is maintained as applied to the amended claims.

### ***Conclusion***

11. No claim is allowed.

12. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark, whose telephone number is (703) 605-1209 (effective mid January 2004, this number will change to (571) 272-0848). The examiner can normally be reached Monday from 8:30 to 5:00, and Tuesday/Thursday from 10:00 to 4:00. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached at (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number for before Final submissions is (703) 872-9306.

Jessica Roark, Ph.D.  
Patent Examiner  
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November 25, 2003

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PRIMARY EXAMINER  
11/25/03